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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,699	09/29/2000	Franz Vossen	00-601	1111

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EXAMINER

CHOI, STEPHEN

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,699

Applicant(s)

VOSSSEN, FRANZ

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-65 is/are pending in the application.
- 4a) Of the above claim(s) 40-46, 48-51, 57-60, 64 and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39, 47, 52-56 and 61-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species E in Paper No. 8 is acknowledged. The traversal is on the ground(s) that Figures 18-22, 25, and 31 are drawn to the elected species and are readable thereupon. This is not found persuasive because Figures 18, 21, and 31 clearly show different embodiments.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The disclosure is objected to because of the following informalities: The usual heading "Background of the Invention", "Summary of the Invention", etc. should be utilized. Page 12, line 9, "46_a" should be --46_n--, line 28, "51" should be --56--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 39, 47, 52-56, and 61-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with vague and indefinite language and should be carefully reviewed. The following are examples of many of the occurrences of such language. Applicant is required to review and correct all the pending claims. Failure to do so may result in the next action made final.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 39 recites the broad recitation "broken-out pieces" and "the movement of the waste portion by the breaking-out tool", and the claim also recites "waste portions" and "adapted to be transferred into an angle of inclination" which is the narrower statement of the range/limitation, claim 55 recites the broad recitation "finger-like fork prongs", and the claim also recites "flat cross-section" and "the free ends of the pressure pin (40) or the fork prong (42, 42_a, 42_b) is in the form of a rough surface" which is the narrower statement of the range/limitation. In claim 39, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

In claim 39, "the direction of movement of the breaking tool", "the edge region", and "said connection pairing" lack positive antecedent basis. Line 29, "in longitudinal

section an angle portion" is grammatically not understood. Line 30, it is not clear what structure "its" is referring back to. Is "a coupling rib" on line 32 the same as "a coupling rib" on line 27?

In claim 47, "the flexible limb" lacks positive antecedent basis.

In claim 52, it is not clear what structure is set forth by "the breaking-out tool or tools extends or extend between surfaces of the support means". The breaking-out tool passes through an opening between surfaces of the support means only when the tool is in operation. "the breaking-out direction" lacks positive antecedent basis. Is this referring to a moving direction of the breaking-out tool or a moving direction of waste portions?

In claim 53, "the free end or ends of the breaking toll" lacks positive antecedent basis. Line 3, it is not clear what structure "its" is referring back to. It is not clear what is meant by "possibly".

In claim 55, "the pressure pin" lacks positive antecedent basis.

In claim 61, "the axial height", "the diameter of the pressure pin", and "the width of the fork prong" lack positive antecedent basis.

In claim 62, it is not clear what structure is set forth by "in inclined relationship". Does this mean projecting teeth, hooks or at least one shoulder is inclined with respect to the prongs?

In claim 63, it is not clear what structure is set forth by "possibly" and "and/or".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 39 and 52-53, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Raveleau (US 6,102,268).

Raveleau discloses the invention substantially as claimed except for a dovetail-shaped configuration. However, Raveleau also teaches (col. 3, lines 38-39) that a head portion can be a large number of shapes. It would have been an obvious matter of design choice to make the different portions of the cross-sections of a receiving groove and the portion forming a coupling rib of whatever form or shape was desired or expedient. It is noted that the invention would perform equally well with the arrangement shown on Raveleau and changing the head portion to dovetail shape configuration with a corresponding recess would perform the same functions. Applicant should note that the limitation "support means" is not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot be used to invoke 35 USC 112, 6th paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence.

7. Claims 54-56 and 61-63, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Raveleau (US 6,102,268) in view of JP 08294898.

The modified device of Raveleau discloses the invention substantially as claimed except for a rough surface. JP 08294898 teaches a pressure pin having a free end with a rough surface (10, 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a rough surface as taught by JP

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08294898 on the modified device of Raveleau in order to provide firm engagement of a tool to the workpiece such as to prevent the workpiece from sliding away. With respect to claims 61-62, see Figure 6.

Conclusion

8. It is noted that claim 47 is not rejected over the prior art. However, the allowability of this claim cannot be indicated at this time in view of clarity issues.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lang, Murray, Vossen, Westermann, Yerly, Bishop, Ersoy, Bakermans et al., Takeuchi et al., Emrich, and Harhay et al. are cited to show related devices.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday thru Friday between 9am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

SC
December 24, 2002


Stephen Choi
Patent Examiner